

REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding. Because the recent closure of Federal Offices during the week of February 7, 2010 prevented Applicant from speaking with the Office and/or scheduling a telephone interview in the subject Application, Applicant expressly reserves the right to a telephone interview with the Office after the submission of this Response.

2. **35 U.S.C. § 103** Claims 1-6, 10-11, 23-28, 32-33, 50-56 and 60-61 are rejected as being unpatentable over "Random Deposit". Applicant respectfully disagrees.

Applicant strenuously objects to the introduction, in item #5 of the Office Action as a very serious distortion to the record. Citing Applicant's remark in the Response of September 8, 2009, "While the practitioner of ordinary skill might reasonably suppose that Random Deposit involves some sort of database, there is no description—explicit, implicit, or inherent—of any particular database architecture", the Office takes a portion of Applicant's remark out of context and presents it in the Office Action as something resembling an admission: "Applicant acknowledges that the practitioner of ordinary skill might reasonably suppose that Random Deposit involves some sort of database . . .", thus seriously miscoloring the original sense of the remark. The presence of the modal verb "might" in the sentence signals a hypothetical statement. Thus, a proper parsing of Applicant's remark would be "Even if it were reasonable for the practitioner of ordinary skill to suppose that Random Deposit involves some sort of database, there is no description—explicit, implicit, or inherent— of any particular database architecture."

In item 6 of the Office Action, the Office asserts that it would have been obvious to have modified Paypal to include separate databases for storing the thin wallet information and full wallet information, providing various rationales in support of its assertion in items 7 and 8. Applicant respectfully disagrees.

Applicant first notes that item 7 describes various scenarios wherein the tasks of a single server have been arbitrarily redistributed across a plurality of servers. However, this situation is inapposite to the subject matter of the Claims. Applicant first points out that nowhere in the Claims is it described that the subscriber database and the wallet database are on different servers. For this reason alone, the rationale of item 7 is not applicable to the presently Claimed subject matter. Furthermore, it appears that the Office has adopted the notion that provision of the wallet database for thick wallets is a simple matter of design choice. Applicant respectfully disagrees. The benefits achieved by providing a wallet database, distinct from the subscriber database, are described extensively, at least at ¶¶ 0036-0039 of U.S. patent application pub. no. 2005/0086068. Thus, the thin wallet, essentially a subscriber record in a subscriber database, as a security measure, to protect sensitive subscriber information, provides the subscriber only read access. On the other hand, the wallet database, in communication with the wallet server, allows read and write access. Additionally, the wallet database provides layered authentication, which the subscriber database does not. The Office has completely failed to identify any teaching from any of the references listed in footnote 1 that provides the benefits afforded by the Claimed subject matter. Accordingly, it is incorrect that the subject matter of the Claims does not provide new or unexpected benefits. Additionally, mere citation of the references in footnote 1, without more, in no way provides the particularized analysis, applying the teaching of the references to the Claim elements, necessary to support the present rejection.

With respect to item 8, it is incorrect that the database architecture described by the Claims is analogous to making functionality, structure or actions separable as in *Dulberg*. As above, the subject matter of the Claims does not merely redistribute tasks between various components of the system that were originally provided by a single component. As above, the subscriber database continues to provide its original function - there is no redistribution of the subscriber database's functions. Again, as described above, the wallet database provides new features that the subscriber database lacks and cannot

provide. Therefore, the Office's analogy is flawed and irrelevant. Even if the Office's analogy were more on-point, the Office's reliance on *Dulberg* as support for its rationale would be misplaced because the facts in *Dulberg*, dealing with removable caps on lipstick cases, are so far removed from the facts of the present case. If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. MPEP § 2144 (III). Here they are not. In fact, the Office fails to make even an attempt to show that the facts in *Dulberg* are of sufficient similarity to the present case. Additionally, because the holding in *Dulberg* has so little to do with the facts of the present Application, the Office's declaration that *Dulberg* renders the subject matter of the Claims obvious as a matter of law is improper.

Furthermore, the notion that the provision of separate wallet and subscriber databases is a simple matter of design choice is not found anywhere in the Application. Rather, it was introduced by the Office in item 5 of the Office Action by the parenthetic expression (the databases may refer to the same database). As above, there is no suggestion anywhere in the Application that the wallet database and the subscriber database can be the same database. Additionally, because Random Deposit is completely silent on the matter of databases, there is no such teaching in the cited reference. Accordingly, the entire notion of separability of the subscriber database from the wallet database is based on a conclusion by the Office that finds no support in the Application, or in the cited references.

Accordingly, in view of the foregoing, the Office provides no valid support for the present rejection. Thus, the present rejection, being based on the improbable supposition that a short paragraph comprising three sentences inherently and/or implicitly teaches or suggests nearly every detail of a complex client-server architecture is based on nothing more than an improper hindsight application of Applicant's own disclosure to the subject matter of the Claims.

In rebuttal, the Office will, of course, cite *In re McLaughlin*. However, "[a]ny judg[e]ment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only

knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.” MPEP 2145 (X)(A), quoting *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)(emphasis added). As above, the Office relies on three sentences from a press release that does not even use the word “database” as implicitly or inherently teaching substantially the entire invention, depending on nothing more than a faulty analogy, its own unsupported conclusions, and irrelevant legal precedent as support for its finding of inherent/implicit teaching.

Accordingly, the present rejection of Claims 1-6, 10-11, 23-28, 32-33, 50-56 and 60-61 is deemed improper. Thus, the same are deemed allowable over the cited reference.

In view of their dependence from allowable parent Claims, the remaining dependent Claims are deemed allowable without any separate consideration of their merits.

3. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on Official Notice, and any other assertions of what is well known or commonly known in the prior art.

CONCLUSION

In view of the foregoing, the Application is deemed in allowable condition. Accordingly, Applicant respectfully requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, he is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,



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